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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,867	12/21/2001	Chan U. Ko	AVERP2997USA	4665

7590 12/06/2004
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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,867

Applicant(s)

KO ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 10-24 and 28-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9, 25-27, 35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/25/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicants' election of Invention Group I, a homopolymer of vinyl chloride for Species Group I (base polymer) in the reply filed on 7/15/2004, and a terpolymer of an olefin, a comonomer selected from (meth)acrylic acids or esters and vinyl acetates, and carbon monoxide for Species Group II (plasticizer) in the reply filed 10/19/2004 is acknowledged. Claims 1-3, 7-9, 25-27, 35 and 36 read on the elected species.

Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Introduction

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Rejections not maintained are withdrawn. In particular, since the elected species are directed to a distinct invention which is not read upon by the previously relied upon prior art references Kushida et al. (US 5344864) or Breton et al. (US 6054524), the rejections in sections 6-8 of Office action dated 3/4/2004 are withdrawn. However, an additional search is required, and it yielded a new reference. The new reference is found to anticipate and/or render obvious the instant claimed invention. Applicants'

comments in the response dated 4/5/2004 regarding the prior art are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1-3, 7-9, 25-27, 35 and 36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 59105045 A (Original and English Abstract).

JP '045 is directed to a highly non-staining non-rigid (flexible) sheet. The sheet comprises a composition of (A) polyvinyl chloride, (B) a terpolymer composed of ethylene, vinyl acetate and carbon monoxide and (C) a polyester plasticizer, such as adipate polyester plasticizer. The components are mixed in the range shown as the

shaded portion surrounded by straight lines in a triangular composition diagram (Abstract and Original).

For claims 1-3, 26, 27, 35 and 36, JP '045 is silent about the elongation property and thickness of the plasticized sheet material. However, since JP '045 is directed to the same subject (a plasticized PVC sheet material) and having the same composition, as set forth above, it is the Examiner's position that, in the absence of unexpected results, suitable elongation and thickness of the flexible sheet are either anticipated by JP '045, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain a suitable plasticized flexible sheet material. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01. Finally, the Examiner would like to note that while the Abstract lacks the thickness of the sheet material of JP '045, the original JP '045 does expressly teach a sheet thickness of 0.2 mm (7.8 mil) (page 4, right column, lower segment, second line), which reads on the instantly claimed thickness.

For claims 7 and 9, the range of each component in the composition diagram, as set forth above, clearly reads on the instantly claimed range limitation.

For claim 25, JP '045 lacks an express teaching that component (B) is liquid. However, since JP '045 teaches the same subject matter and having the same composition, as set forth above, it is the Examiner's position that, in the absence of unexpected results, a suitable liquid component (B) is either anticipated by JP '045, or

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an obvious selection and/or optimization to one of ordinary skill in the art, motivated by the desire to obtain a suitable blended composition for sheet or film forming.

7. Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 59105045 A (Original and English Abstract), and further in view of Green et al. (US 3973563).

The teachings of JP '045 are again relied upon as set forth above.

For claim 8, JP '045 lacks a teaching that the flexible sheet is pigmented. However, it is noted that Green is directed to a highly conformable PVC backing for bandage application (column 9, lines 46-51), and Green expressly teaches that additives such as pigment can be used to impart color thereto (column 4, lines 64-67). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify JP '045 with pigment, as taught by Green, motivated by the desire to obtain an aesthetic effect.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making conformable plasticized PVC film:

US 3780140 to Hammer is directed to a flexible film comprising PVC and a terpolymer blend.

US 4123585 to Sparzak et al. discloses a composition which comprises vinyl halide polymers, a terpolymer, and a mixed alkyl phthalate (Abstract).

Conclusion


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vsc
Victor S Chang
Examiner
Art Unit 1771

11/17/2004


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